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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,103	01/17/2002	Takeshi Miyakawa	217829USOPCT	2093
22850	7590	05/10/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			NOLAN, SANDRA M	
			ART UNIT	PAPER NUMBER

1772

DATE MAILED: 05/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/030,103

Applicant(s)

MIYAKAWA ET AL.

Examiner

Sandra M. Nolan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1-12-04, 2-26-04 and 4-20-04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Communications from Applicants

1. The examiner notes that, subsequent to the office action dated 13 August 2003 (1000301303(7), written on 05 August 2003), applicants have submitted papers on the following dates: 12 January 2004, 26 February 2004 and 20 April 2004.

Claims

2. As shown in the 26 February 2004 letter, the pending claims are claims 2-12, claim 1 having been cancelled by applicants.

Examiner's Summary of Pending Claims

3. The base claims of this application are claims 4 and 8:

Claim 4 covers a sheet comprising:

a) a base sheet of polyethylene terephthalate (PET) and polycarbonate-type (PC) resin,

b) at least one surface layer of PC resin on sheet a),

c) at least one coating layer on surface layer b),

with added limitations re: (i) the PET and PC content of a), (ii) the thickness of b) and (iii) the specific resistance of c).

Claim 8 covers a carrier tape comprising a), b) and c), with limitations (i) and (ii).

The descriptions of a), b), c), (i) and (ii) in claim 8 are identical to those in claim 4.

4. Dependent claims 5-7 and 10-12 derive from claim 4.

5. Dependent claims 2-3 and 9 derive from claim 8.

Rejection Maintained

6. The 35 USC 103 rejection of claims 7-11 has unpatentable over Miyamoto et al (US 5,208,103) in view of Kadoya (HEI 11[1999]-77938), recited in section 9 of the 13 August 2003 office action [1000301303(7)], is maintained for reasons of record.

Rejections Withdrawn

7. The 35 USC 102 rejection of claims 1-3 as anticipated by Kadoya is withdrawn in view of applicants' amendments to the claims in the 26 February 2004 letter.

8. The 35 USC 103 rejection of claims 4-10 as obvious over Kadoya taken with JP 05294376A's abstract, as recited in section 7 of the 13 August 2003 office action, is withdrawn in order to apply a new ground of rejection, recited below.

9. The 35 USC 103 rejection of claims 410 as obvious over Kadoya taken with Kitaoka (JP-11-147569), as expressed in section 8 of the 13 August 2003 office action, is withdrawn in order to apply a new ground of rejection, recited below.

New Rejections

Claim Rejections - 35 USC § 103

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 2-12 are rejected under 35 U.S.C. 103(a) as being obvious over Kadoya taken with JP 05294376A's abstract for reasons of record.

The Kadoya reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome

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by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Kadoya and JP 05294376A's abstract are described and applied in sections 4 and 7, respectively, of the 13 August 2003 office action. Those discussions apply here.

12. Claims 2-12 are rejected under 35 U.S.C. 103(a) as being obvious over Kadoya taken with Kitaoka for reasons of record.

The Kadoya reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an

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invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Kadoya and Kitaoka are described and applied in sections 4 and 8, respectively, of the 13 August 2003 office action. Those discussions apply here.

Response to Arguments

13. Applicant's arguments with respect to claims 4-11 have been considered but are moot in view of the new grounds of rejection above.

14. Also, Applicant's arguments filed in the 12 January 2004 and 26 February 2004 letters have been fully considered but they are not persuasive.

15. In the Remarks section of the 12 January 2004 letter at page 6, applicants argue that the 103 rejections "may be overcome by a showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject [to] an obligation of assignment to the same person".

However, no such showing was presented in the 12 January 2004 letter or the 26 February 2004 letter.

16. In the Remarks section of the 12 January 2004 letter at pages 6 and 7, applicants state that one of ordinary skill would have no reason or incentive to combine the Kadoya teaching with the teachings of the secondary references.

However, the examiner has provided motivation to combine the teachings of Kadoya with those of the JP 05294376A abstract and Kitaoka, under 35 USC 103, on pages 4 and 6, respectively, of the 13 August 2003 office action. Applicants have not presented detailed arguments or objective evidence that overcomes the 35 USC 103 rejections.

Final Rejection

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

18. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from its mailing date. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action.

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19. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

Any inquiry concerning this communication should be directed to Sandra M. Nolan, whose telephone number is 571/272-1495. She can normally be reached on Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time. If attempts to reach the examiner are unsuccessful, her supervisor, Harold Pyon, can be reached at 571/272-1498. The fax number for patent application documents is 703/872-9306.



S. M. Nolan
Primary Examiner
Technology Center 1700

SMN/smn
10030103(20040506)